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Docket No. 2877-4031**REMARKS**

Claim 11 is canceled. Claims 1-10 and 12-41 are pending. Claims 1-3 and 16-41 are withdrawn by the Examiner subject to the restriction requirement of July 8, 2005.

No amendments are made. For the convenience of the Examiner, a listing of claims begins on page 2 of this paper.

Applicants respectfully thank the Examiner for the withdrawal of all previous rejections.

**Rejections Under 35 U.S.C. § 103(a)**

Claims 4-8, 10, and 12-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Podell (U.S. Pat. No. 4,575,476) in view of Teoh (WO 0232475). The Office Action states that Podell discloses a glove coated with a hydrogel layer and a silicone and cationic surfactants such as N-cetylpyridinium chloride (Office Action, page 2). The Office Action further states that Podell "recognizes the use an ammonium phosphate surfactant. (Table 7)" but that Podell is silent on the use of the specific alkyl ammonium phosphate of the present invention. The Examiner seeks to cure the deficiency of Podell by referring to Teoh's Example 1, which includes silicone, Darvan L, and cetyl pyridinium chloride on the surface of a glove. The Examiner concludes that the motivation of using the surfactant composition comprising Darvan L is to "afford a hydrogel-coated glove with excellent anti-tack properties," and that it would have been obvious to incorporate Darvan L to Podell's surfactant composition with expected success.

Applicants respectfully traverse the rejection on the basis that there is no motivation to combine the references and that the Office Action relies on improper hindsight reconstruction.

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Docket No. 2877-4031**The Cited Art Does Not Suggest the Desirability of the Combination**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the case of the cited references, there is nothing in the cited art to suggest the combination of the references, or that would lead one of ordinary skill in the art with Podell in hand to look to Teoh as the solution to any problems in Podell. The Office Action states that Podell "recognizes the use an ammonium phosphate surfactant (Table 7)" but that Podell is silent on the use of the specific alkyl ammonium phosphate of the present invention. This is an incorrect representation of the teachings of Podell. In fact, Podell discloses "oxyethyl alkyl ammonium phosphate" in Table 7, which is chemically and structurally distinct from ammonium salts of alkyl phosphates. There is nothing in the prior art cited by the Examiner to suggest that oxyethyl alkyl ammonium phosphate is equivalent to or suitable to be replaced by ammonium salts of alkyl phosphates. Applicants pointed out the differences between oxyethyl alkyl ammonium phosphate and ammonium salts of alkyl phosphates in the previous response, and in return, the previous rejection over 35 U.S.C. § 102(b) was withdrawn. The Examiner has therefore acknowledged that oxyethyl alkyl ammonium phosphate and ammonium salts of alkyl phosphates are different chemical entities with different properties, but provided no rationale for why the Office Action now suggests that the two different chemical entities are interchangeable.

As acknowledged by the Examiner, Podell fails to disclose ammonium salts of alkyl phosphates. In addition, there is no evidence in Podell to suggest that the damp skin lubricity rating of Podell's examples is related to the antitack property, friction-reducing property or the

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double donnability of glove surfaces claimed in the instant application in claims 12-15. Teoh is entirely silent with respect to the advantages of modifying Podell to replace oxyethyl alkyl ammonium phosphate with ammonium salts of alkyl phosphates. On the contrary, Teoh teaches an entirely separate invention. The references teach inventions that appear to be entirely sufficient on their own, with no suggestion to incorporate the designs of the other. Therefore, nothing in Podell or Teoh suggests the replacement or addition of ammonium salts of alkyl phosphates in the compositions of Podell.

### **Improper Hindsight Reconstruction**

The Office Action relies on Teoh to remedy the deficiencies of Podell. However, the Office Action uses improper hindsight reconstruction to combine the two references. It is a well-established point of law that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of invention would make the combination of two or more references. The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In the present case, there is no suggestion in either Podell or Teoh of the desirability of the replacement or addition of ammonium salts of alkyl phosphates in the compositions of Podell.

The Office Action concludes that the motivation of using a surfactant composition comprising Darvan L is to "afford a hydrogel-coated glove with excellent anti-tack properties," and that it would have been obvious to incorporate Darvan L to Podell's surfactant composition with expected success (Office Action, page 3, lines 6-10). However, neither Podell nor Teoh provide this teaching. In fact, the oxyethyl alkyl ammonium phosphate disclosed by Podell is just one of many ingredients disclosed in Table 7, which the Examiner has determined it is obvious

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to replace for no particular reason. Nothing in Podell or Teoh suggests a deficiency in oxyethylalkyl ammonium phosphate which would necessitate its removal and replacement with an entirely different class of chemicals. Therefore, one of ordinary skill in the art has no reason (absent improper hindsight reconstruction based on Applicants' own disclosure) to randomly target one of many components taught by Podell as being obvious to replace.

A person of ordinary skill in the art would have no expectation of success in randomly picking and choosing one isolated component from Teoh to add to Podell's compositions to obtain the claimed invention. Teoh specifically teaches that "It is to be understood that only certain anti-tack agents work effectively in the present process and that some anti-tack agents are clearly unsuitable" (Teoh, page 4, lines 13-15). In fact, all of Teoh's compositions comprise **neoprene**. Teoh reports that "surprisingly...we have found that hydrogels suitable for slip coatings can be coated easily and conveniently onto coagulated **neoprene** and **neoprene** copolymer" (Teoh, page 6, lines 2-4, emphasis added). The instant claims do not require neoprene (i.e. polychloroprene), but rather require natural rubber latex, synthetic polyisoprene, nitrile, and blends thereof. Teoh teaches away from the addition of components in his composition to other compositions by clearly indicating that only certain agents work while others are unsuitable, that Teoh's results are surprising, and that Teoh's results only hold for neoprene elastomers. Therefore, the motivation to replace or add ammonium salts of alkyl phosphates to the compositions of Podell is entirely provided by the Examiner, which involves improper hindsight reconstruction of the Applicants' own invention by piecemeal selection of references to arrive at the instantly claimed invention.

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Podell (U.S. Pat. No. 4,575,476) in view of Teoh (WO 0232475) and further in view of Yeh (U.S. Pat.

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No. 6,347,408). Applicants respectfully traverse the rejection on the basis that there is no motivation to combine Podell and Teoh absent improper hindsight reconstruction, as discussed above. Without the combination of Podell and Teoh, Yeh fails to remedy the deficiencies of either reference alone.

### CONCLUSION

Based on the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

### AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. 2877-4031. A DUPLICATE OF THIS SHEET IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 2877-4031. A DUPLICATE OF THIS SHEET IS ATTACHED.

Respectfully submitted,  
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Dated: June 29, 2006

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